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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,031	01/16/2001	Richard E. Rowe	29757/P-265	4234

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EXAMINER	
ASHBURN, STEVEN L	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/761,031	ROWE, RICHARD E.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 54 depends upon itself. As a result, there is insufficient antecedent basis for this limitations in the claim. Consequently, the claim is rejected for being indefinite. Claims 51 and 53 depend upon claim 54 and thereby inherit its deficiency.

Claim 52 depends upon claim 55. There is no claim 55. As a result, there is insufficient antecedent basis for this limitations in the claim. Consequently, the claim is rejected for being indefinite.

For the purposes of examination, the examiner assumes that claims 51-54 depend upon claim 50.

Claim Rejections - 35 USC § 102

Claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al., U.S. Patent 6,089,976 (Jul. 18, 2000)

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 41 and 46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schneider.

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claim Rejections - 35 USC § 103

Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider.

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 3-5, 11-13, 19-21, 27-29, 35-37, 42-44, 51, 52, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider in view of Walker et al., U.S. Patent 6,110,041 (Aug. 29, 2000)

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 6, 14, 22, 30, 38, 45 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider in view of Burns et al., U.S. Patent 6,048,269 (Apr. 11, 2000) and Saunders et al., U.S. Patent 6,340,331 B1 (Jan. 22, 2002).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 8, 16, 24, 32, 40 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider in view Adams, U.S. Patent 6,113,098 (Sep. 5, 2000).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

Applicant's arguments filed April 30, 2004 have been fully considered but they are not persuasive. The examiners responses are provided below.

Regarding claims 1-49, the applicant argues that the amended claims distinguish over the prior art because Schneider does not disclose or suggest that the bonus amount be paid to the player based on the player's selection to have the bonus amount paid. The examiner respectfully disagrees. The argument is unpersuasive because the feature upon which applicant relies is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In particular, the claims as amended does not require that a bonus amount be paid to the player based on the player's selection to have the bonus amount paid. Instead the claims require that a bonus amount be paid "in response to detecting a bonus payout dispensing selection by the user". Schneider discloses this feature. More specifically, it dispenses a bonus amount in response to detecting a selection by a player causing a match. *See col. 3:28-35.* Thus, Schneider discloses the limitation of paying a bonus amount in response to detecting a bonus payout dispensing selection by the user. Consequently, the rejections of claims 1-49 provided the office action dated December 30, 2003 are maintained.

Regarding claims 50-54, the applicant argues that the new claims distinguish over the prior art because Schneider does not disclose or suggest the feature of entry into the bonus game independently of the amount wagered. The examiner respectfully disagrees. Again, the argument is unpersuasive because the feature upon which applicant relies is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In particular, the claims do not require entry into the bonus game independently of the amount wagered. Instead the claims require a triggering event being independent of the amount wagered. Schneider discloses a gaming device in which entry into the bonus game requires (1) a qualifying hand and (2) a maximum bet. *See col. 3:21-28.* The qualifying hand is the event which triggers the bonus game. Qualifying hands occur independent of

whether or not a maximum bet has been wagered. Thus, although Schneider does not disclose a bonus game which occurs independently of the amount wagered, it does disclose triggering events that are independent of the amount wagered. Consequently, new claims 50-54 fail to overcome the rejections provided the office action dated December 30, 2003.

Prior Art, Not Relied On

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

EP-0281402 discloses a gaming device that dispenses a payout equal to the jackpot prize when a player presses a jackpot button. Alternatively, the jackpot prize may be paid automatically.

US 5,722,891 discloses a gaming device having a secondary game wherein entry into the bonus game independently of the amount wagered in the primary game.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru

Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, primary examiner Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

MARK SAGER
PRIMARY EXAMINER